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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/782,981

02/20/2004

Rafail Zubok

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LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

EXAMINER

PELLEGRINO, BRIAN E

ART UNIT

PAPER NUMBER

3738

MAIL DATE

DELIVERY MODE

10/09/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/782,981

Applicant(s)

ZUBOK ET AL.

Examiner

Brian E. Pellegrino

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2007.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 9, 11-16 and 20-24 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-3, 5, 6, 9-16, 20-22 and 24 is/are rejected.
7) ☒ Claim(s) 4 and 23 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 7/16/07.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-3,5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aebi et al. (6261296) in view of Keller (4997432). Aebi et al. show (Fig. 14) an instrument **200** for distracting vertebrae with two elongated sections **212** with each having two prongs **214** with a passage between the sides of the arms that is capable of holding an artificial disc. It can be seen there are curved portions at the distal ends of the arms of the tool to have a curved cross-section. It is also clear that they are separate arms and thus can be considered to be releasable. Please note the intended use carries no weight in the absence of any distinguishing structure. It can be construed that since the prong sections extend upward it forms what can be construed as a ridge.

However, Aebi et al. fail to disclose the interior side of the distal end of the elongated sections having laterally spaced grooves.

Keller teaches (Figs. 3-5) that the ends of an instrument for an implant have grooves **20** for accommodating the implant.

It would have been obvious to one of ordinary skill in the art to use grooves as taught by Keller

with the implantation device of Aebi et al. such that it better grips the implant and prevents it from sliding within the tool.

Claims 6,22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aebi et al. '296 in view of Keller '432 as applied to claim 1 above, and further in view of Neumann (EP 1219266). Aebi et al. in view of Keller is explained above. However, Aebi as modified by Keller fail to disclose a longitudinal aperture formed on an elongated section. Neumann teaches (Fig. 10) an elongated aperture in the tool for receiving another tool. It would have been obvious to one of ordinary skill in the art to incorporate an elongate aperture in the tool of Aebi as modified by Keller per the teaching of Neumann such that it provides the surgeon the ability to use other tools with the delivery instrument. Regarding claim 22, it would have been an obvious expedient to use an aperture in the first and second elongate sections such that it would enable the surgeon to use two different tools with the delivery instrument.

Claims 1,5,20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Urbahns et al. (6159215) in view of Aebi et al. '296. Urbahns et al. disclose (Fig. 13) an instrument with two elongate sections **512,514** having interior grooves the entire length and a transverse ridge **518** on an exterior surface. However, Urbahns et al. fail to disclose the distal ends of the elongate sections have two prongs. It is noted that Urbahns et al. has extending sections on the elongate arms of the instrument. Aebi et al. is explained supra. It would have been obvious to one of ordinary skill in the art to use prongs on the ends of the arms or elongate sections of the instrument of Urbahns et

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al. per the teaching of Aebi et al. such that it provides more versatility and allows for easier insertion when irregularities in the vertebrae is encountered during insertion.

Claims 9,11,13-16,24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Urbahns et al. (6159215) in view of Baumgartner (5370697). Urbahns et al. is explained supra. However, Urbahns et al. fail to disclose the ramps have concave inner sides. Baumgartner teaches (Figs. 1a,5) an implant with an exterior surface that is convex. It would have been obvious to one of ordinary skill in the art to modify the delivery device ramps of Urbahns et al. tool and form them with concave inner surfaces to match the contour of the implant per the teaching of Baumgartner such that an implant that requires a convex exterior surface to match the vertebrae is able to be used for the patient and the tool is able to accommodate its structure.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Urbahns et al. '215 in view of Baumgartner '697 as applied to claim 9 above, and further in view of Aebi et al. '296. Urbahns et al. in view of Baumgartner is explained supra. However, Urbahns as modified by Baumgartner fail to disclose prongs at the end of the instrument. Aebi et al. is also explained as before. It would have been obvious to one of ordinary skill in the art to use prongs at the end of the instrument as taught by Aebi et al. with the instrument of Urbahns et al. as modified by Baumgartner such that it provides greater versatility and room for the implant structure and ability to be placed within the vertebral space.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Urbahns et al. '215 in view of Aebi et al. '296 as applied to claim 1 above, and further in view of

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Baumgartner '697. Urbahns as modified by Aebi is explained supra. However, Urbahns in view of Aebi fail to disclose the inner surfaces of the elongate sections are curved. Baumgartner is also explained above. It would have been obvious to one of ordinary skill in the art to use curved inner surfaces on the elongate sections of the instrument as taught by Urbahns et al. as modified by Aebi such that it provides a better match or corresponding structure to an implant that has an outer convex structure as taught by Baumgartner to match the curve of the vertebrae in a patient.

Allowable Subject Matter

Claims 4,23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 7/16/07 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609.04(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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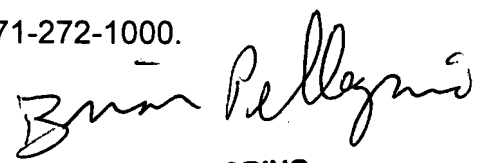
shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Pellegrino whose telephone number is 571-272-4756. The examiner can normally be reached on M-F (8:30am-5pm) .

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TC 3700, AU 3738


BRIAN E. PELLEGRINO
PRIMARY EXAMINER